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7590 Gunnar G. Leinberg, Esq. Nixon Peabody LLP, Clinton Square P.O. Box 31051 Rochester, NY 14603-1051		12/04/2009	EXAMINER LOFTIS, JOHNNA RONEE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES

6

7

8 *Ex parte P. HAMILTON CLARK III, JOEL S. CORNELL,*
9 KATHY CUPO, WILLIAM KANE, PATRICIA A. LAURIA,
10 JANICE L. MALASZENKO, AUDREY T. PANTAS,
11 AND J. TED POTTER

12

13

14 Appeal 2009-008508
15 Application 09/950,087
16 Technology Center 3600

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19 Decided: December 4, 2009

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22 Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
23 MOHANTY, *Administrative Patent Judges.*

24 FETTING, *Administrative Patent Judge.*

25 DECISION ON APPEAL

26

1 STATEMENT OF THE CASE

2 P. Hamilton Clark III, Joel S. Cornell, Kathy Cupo, William Kane,
3 Patricia A. Lauria, Janice L. Malaszenko, Audrey T. Pantas, and J. Ted
4 Potter (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final
5 rejection of claims 1-30, the only claims pending in the application on
6 appeal.

7 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
8 (2002).

9 SUMMARY OF DECISION¹

10 We AFFIRM.

11 THE INVENTION

12 The Appellants invented a way of managing projects using phases
13 (Specification 1:¶ 0001).

14 An understanding of the invention can be derived from a reading of
15 exemplary claim 1, which is reproduced below [bracketed matter and some
16 paragraphing added].

17 1. A method for managing a project, the method comprising:

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.", filed January 24, 2007) and Reply Brief ("Reply Br.", filed February 17, 2009), and the Examiner's Answer ("Ans.", mailed December 15, 2008).

- [1] creating at least one phase for the project;
- [2] identifying which of one or more stored exit criteria are applicable to at least one of the phases of the project;
- [3] establishing the identified one or more stored exit criteria for the at least one phase, the one or more exit criteria based at least partially on experience gained from one or more prior projects;
- [4] determining whether each of the identified one or more stored exit criteria have been satisfied for the at least one phase; and
- [5] advancing the project to a next one of the phases based on the determination of whether each of the identified one or more stored exit criteria have been satisfied for the at least one phase.

THE REJECTIONS

16 The Examiner relies upon the following prior art:

McAtee US 5,301,320 Apr. 5, 1994

17 Claims 1-6 and 9-22 stand rejected under 35 U.S.C. § 101 as directed
18 to non-statutory subject matter.

19 Claims 1-5, 7-11, 13-17, 19-21, 23-25, and 27-29 stand rejected under
20 35 U.S.C. § 102(b) as anticipated by McAtee.

21 Claims 6, 12, 18, 22, 26, and 30 stand rejected under 35 U.S.C.
22 § 103(a) as unpatentable over McAtee.

ARGUMENTS

Claims 1-6 and 9-22 rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

The Appellants argue that the claims require a device with memory to store the claimed data and so the claims are statutory. Reply Br. 2.

8 The Appellants argue the claims together, and so we treat them as
9 argued as a group. Accordingly, we select claim 1 as representative of the
10 group. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

The Appellants contend that McAtee fails to describe identifying which of one or more stored exit criteria are applicable to a project phase. App. Br. 8. The Appellants further contend that even if McAtee’s tasks are retrieved at some later time to create a program, it is not by way of identifying which of one or more stored exit criteria are applicable. The Appellants also contend that McAtee fails to describe establishing the identified one or more stored exit criteria, because McAtee’s designer enters the information. App. Br. 9

Claims 6, 12, 18, 22, 26, and 30 rejected under 35 U.S.C. § 103(a) as unpatentable over McAtee.

21 These claims further require making the information accessible through
22 a web page. The Examiner found that it would have been obvious to do so
23 because one could then access the data anywhere. Ans. 10. The Appellants
24 rely on their arguments in support of the independent claims for this

¹ rejection, and further argue that McAtee fails to show such internet access.
² App. Br. 11-12.

ISSUES

4 The issue of whether the Appellants have sustained their burden of
5 showing that the Examiner erred in rejecting claims 1-6 and 9-22 under
6 35 U.S.C. § 101 as directed to non-statutory subject matter turns on whether
7 the process claims are statutory and whether the system and computer
8 readable media claims are drawn to more than just the process claims.

9 The issue of whether the Appellants have sustained their burden of
10 showing that the Examiner erred in rejecting claims 1-5, 7-11, 13-17, 19-21,
11 23-25, and 27-29 under 35 U.S.C. § 102(b) as anticipated by McAtee turns
12 on whether McAtee describes the limitation [2] of identifying which of one
13 or more stored exit criteria are applicable to at least one of the phases of the
14 project.

15 The issue of whether the Appellants have sustained their burden of
16 showing that the Examiner erred in rejecting claims 6, 12, 18, 22, 26, and 30
17 under 35 U.S.C. § 103(a) as unpatentable over McAtee turns on whether one
18 of ordinary skill would have found it predictable to make McAtee's output
19 accessible over the internet.

FACTS PERTINENT TO THE ISSUES

21 The following enumerated Findings of Fact (FF) are believed to be
22 supported by a preponderance of the evidence.

1 *Facts Related to the Prior Art*

2 *McAtee*

- 3 01. McAtee is directed to automated processing of business tasks
4 configured to define, execute, monitor and control the flow of
5 business operations. McAtee 1:8-12.
- 6 02. McAtee describes the then existing business environment as an
7 organized sequence of activities whose ultimate purpose, or goal,
8 is to produce a product or provide a service. Each business
9 activity in the sequence involves performance of one or more
10 items of work that bring the business one step closer to
11 completion of the goal. McAtee 1:14-20.
- 12 03. Such activities may be strictly ordered with respect to one
13 another, conditionally ordered or completely unordered; they may
14 be automated, partially automated or performed manually; and
15 may be performed using resources within or outside the business.
16 McAtee 1:20-24.
- 17 04. Individual work items, termed works in process (WIP),
18 progress through the sequence of activities until they have been
19 transformed into a finished item; that is, until the ultimate goal is
20 achieved. McAtee 1:25-31.
- 21 05. With McAtee's system, a designer first defines a workflow by
22 providing the system with a template of business activities that
23 expresses the manner in which these activities relate to one
24 another. Then the system and staff perform the various business
25 tasks that define the work-flow in accordance with the workflow

1 template. The configured system supervises and orchestrates
2 performance of these tasks so that they occur in the specified
3 order. The system represents workflow tasks in a fully modular
4 fashion, so that an identifier for each task, along with a
5 specification of the activities necessary for its completion and the
6 manner in which the task relates to other tasks, are stored as a
7 discrete, self-contained package. McAtee 2:35-57.

8 06. To configure the system for a particular application, McAtee's
9 designer first defines the workflow by decomposing the business
10 process into an ordered description of discrete goals. Each goal
11 can represent the completion of a business task or activity, or the
12 occurrence of a specific business-related event. McAtee 3:51-57.
13 Before accessing McAtee's workflow system, a designer first
14 breaks down the sequence of business operations into a series of
15 goals, each of which represents a discrete business activity. Each
16 goal is then further decomposed into the tasks necessary for its
17 accomplishment. McAtee 5:25-30.

18 07. The size of a compound goal (i.e., the number of component
19 goals it specifies) is determined by the designer. If a series of
20 sequential tasks tend to be performed in association with one
21 another, so that in altering the workflow the designer would be
22 likely to shift, as a group, the relationship of these tasks to other
23 tasks, such tasks may be packaged as a single compound goal
24 consisting of multiple primitive goals. If multiple parallel tasks
25 must all be completed before the next goal can become active, the

1 parallel tasks are typically gathered into a single compound goal.

2 McAtee 5:43-54.

3 08. The designer develops this workflow using an editing facility to
4 generate a database of workflow descriptions that includes goals,
5 relationships among goals and characteristics associated with each
6 goal. These are interpreted and processed to implement and
7 enforce the workflow. The user enters this description
8 information into a data structure for each goal, and the set of data
9 structures for all goals is organized into a table. The fields for
10 each goal can include events that trigger other goals. McAtee
11 5:67 - 6:23.

12 09. Activities that are assigned to achieve goals are designated as
13 either tasks or events depending on whether they are implemented
14 inside or outside the system. McAtee 6:62-64.

15 10. *Facts Related To The Level Of Skill In The Art*

16 11. Neither the Examiner nor the Appellants has addressed the level
17 of ordinary skill in the pertinent arts of systems analysis and
18 programming, project management systems design, and internet
19 publishing. We will therefore consider the cited prior art as
20 representative of the level of ordinary skill in the art. *See Okajima*
21 *v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he
22 absence of specific findings on the level of skill in the art does not
23 give rise to reversible error ‘where the prior art itself reflects an
24 appropriate level and a need for testimony is not shown’”)

(quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

12. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Statutory Processes

8 The law in the area of patent-eligible subject matter for process claims
9 has recently been clarified by the Federal Circuit in *In re Bilski*, 545 F.3d
10 943 (Fed. Cir. 2008) (en banc), *cert. granted*, 77 USLW 3442 (U.S. Jun. 1,
11 2009) (No. 08-964).

The en banc court in *Bilski* held that “the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101.” *Id.* at 956. The court in *Bilski* further held that “the ‘useful, concrete and tangible result’ inquiry is inadequate [to determine whether a claim is patent-eligible under § 101.]” *Id.* at 959-60.

17 The court explained the machine-or-transformation test as follows: “A
18 claimed process is surely patent-eligible under § 101 if: (1) it is tied to a
19 particular machine or apparatus, or (2) it transforms a particular article into a
20 different state or thing.” *Id.* at 954 (citations omitted). The court explained
21 that “the use of a specific machine or transformation of an article must
22 impose meaningful limits on the claim’s scope to impart patent-eligibility”
23 and “the involvement of the machine or transformation in the claimed
24 process must not merely be insignificant extra-solution activity.” *Id.* at 961-

1 62 (citations omitted). As to the transformation branch of the inquiry, the
2 court explained that transformation of a particular article into a different
3 state or thing “must be central to the purpose of the claimed process.” *Id.*

4 *Anticipation*

5 “A claim is anticipated only if each and every element as set forth in
6 the claim is found, either expressly or inherently described, in a single prior
7 art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d
8 628, 631 (Fed. Cir. 1987). “When a claim covers several structures or
9 compositions, either generically or as alternatives, the claim is deemed
10 anticipated if any of the structures or compositions within the scope of the
11 claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.
12 Cir. 2001). “The identical invention must be shown in as complete detail as
13 is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d
14 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by
15 the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology
16 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

17 *Obviousness*

18 A claimed invention is unpatentable if the differences between it and
19 the prior art are “such that the subject matter as a whole would have been
20 obvious at the time the invention was made to a person having ordinary skill
21 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 550
22 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

24 In *Graham*, the Court held that that the obviousness analysis is
25 bottomed on several basic factual inquiries: “[1] the scope and content of
26 the prior art are to be determined; [2] differences between the prior art and

1 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
2 in the pertinent art resolved.” 383 U.S. at 17. *See also KSR*, 550 U.S. at
3 406. “The combination of familiar elements according to known methods is
4 likely to be obvious when it does no more than yield predictable results.” *Id.*
5 at 416.

6 ANALYSIS

7 *Claims 1-6 and 9-22 rejected under 35 U.S.C. § 101 as directed to non-*
8 *statutory subject matter.*

9 We apply the machine-or-transformation test, as described in *Bilski*, to
10 determine whether the subject matter of process claims 1-6 and 9-22 are
11 patent-eligible under 35 U.S.C. § 101.

12 Process claims 1-6 and 9-22 recite a series of process steps that are not
13 tied in any manner to a machine, other than referring to stored data. The
14 claims do not narrow the manner or structural form of such storage. In other
15 words, these claims do not limit the process steps to any specific machine
16 or apparatus. Thus, the claims fail the first prong of the machine-or-
17 transformation test because they are not tied to a particular machine or
18 apparatus.

19 The steps of process claims 1-6 and 9-22 also fail the second prong
20 of the machine-or-transformation test because the data does not represent
21 physical and tangible objects.² Rather, the data represents information about

² Because the data does not represent physical and tangible objects, we need not reach the issue of whether mere calculation of a number based on inputs of other numbers is a sufficient “transformation” of data to render a process patent-eligible under § 101.

1 decision criteria, which are intangible attributes. Thus, the process of claims
2 1-6 and 9-22 fails the machine-or-transformation test and is not patent-
3 eligible under 35 U.S.C. § 101.

4 *Claims 1-5, 7-11, 13-17, 19-21, 23-25, and 27-29 rejected under 35 U.S.C.
5 § 102(b) as anticipated by McAtee.*

6 McAtee's system is configured to define, execute, monitor and control
7 the flow of business operations. FF 01. We find that claim 1 is generally
8 drawn to project management (claim 1 preamble), which McAtee describes
9 as part of the then existing business environment. FF 02. McAtee describes
10 as commonplace that project management as a discipline or process orders
11 and executes tasks either manually or by automation until an ultimate goal is
12 achieved. FF 03 - 04. Thus, if limitation [2] recited using exit criteria
13 generally, instead of stored exit criteria, claim 1 would be little more than an
14 explicit recitation of how the tasks in projects such as those described in
15 McAtee's background were carried out.

16 Limitation [2] requires identifying which of one or more stored exit
17 criteria are applicable to at least one of the phases of the project. The
18 Examiner found that McAtee described assigning such exit criteria and
19 storing them in a manner that identified which project phases they applied
20 to. Ans. 6-7 and 10-11. We agree with the Examiner that McAtee describes
21 assigning such exit criteria (FF 05 & 06) and storing them in a manner that
22 identified which project phases they applied to (FF 07).

23 The Appellants contend that in contrast with claim 1, McAtee involves
24 a designer conceptualizing a workflow decomposition and creating a
25 workflow template. App. Br. 8:Last full ¶. It is unclear how the Appellants

1 are attempting to so distinguish the claim from McAtee because nothing
2 in claim 1 would preclude performing the creation, identification, and
3 establishment in steps [1]-[3] by way of creating a template as in McAtee
4 that is later read to direct the flow of steps [4] and [5]. If the Appellants are
5 arguing that steps [1]-[3] are not carried out dynamically during project
6 execution, such an argument is simply not commensurate with the scope of
7 the claims.

Claims 6, 12, 18, 22, 26, and 30 rejected under 35 U.S.C. § 103(a) as unpatentable over McAtee.

10 Here, the sole issue is whether one of ordinary skill would have found
11 it predictable to make information sought accessible through a web page.
12 The Examiner's findings implicitly found it was so predictable. The
13 Appellants do not answer this, but instead merely argues that McAtee fails
14 to describe this, or would change the principle of McAtee's operation. App.
15 Br. 11. The Appellants do not describe just how this would change the
16 principle of McAtee's operation, but we take this argument to be the same as
17 the argument regarding the timing of the identifying step in limitation [2]
18 with claim 1. As with claim 1, such an argument is not commensurate with
19 the scope of the claim. Certainly, simply making information available over
20 the internet would not be incompatible with McAtee, and we agree with the
21 Examiner that the notoriety of using the internet to make information
22 accessible from any computer was well known and practiced by those of
23 ordinary skill. Thus, we find the Appellants' arguments unpersuasive.

CONCLUSIONS OF LAW

2 The Appellants have not sustained their burden of showing that the
3 Examiner erred in rejecting claims 1-6 and 9-22 under 35 U.S.C. § 101 as
4 directed to non-statutory subject matter.

5 The Appellants have not sustained their burden of showing that the
6 Examiner erred in rejecting claims 1-5, 7-11, 13-17, 19-21, 23-25, and 27-29
7 under 35 U.S.C. § 102(b) as anticipated by McAtee.

8 The Appellants have not sustained their burden of showing that the
9 Examiner erred in rejecting claims 6, 12, 18, 22, 26, and 30 under 35 U.S.C.
10 § 103(a) as unpatentable over McAtee.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1-6 and 9-22 under 35 U.S.C. § 101 as directed to non-statutory subject matter is sustained.
 - The rejection of claims 1-5, 7-11, 13-17, 19-21, 23-25, and 27-29 under 35 U.S.C. § 102(b) as anticipated by McAtee is sustained.
 - The rejection of claims 6, 12, 18, 22, 26, and 30 under 35 U.S.C. § 103(a) as unpatentable over McAtee is sustained.

19 No time period for taking any subsequent action in connection with
20 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Appeal 2009-008508
Application 09/950,087

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